

III. REMARKS

1. Applicant respectfully submits that claims 1-20 are not unpatentable over "Toshiba" in view of Kohorn ('752), further in view of Kara ('568) and Ryan ('795) under 35 U.S.C. §103(a). With regard to references previously cited by the Examiner, Applicant incorporates herein by reference in their entireties the arguments previously presented.

First, the combination of references currently being cited by the Examiner in this prosecution once do not disclose or suggest each and every feature of Applicant's invention as required under 35 U.S.C. §103(a). Second, the motivation required to combine references to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) is not present in any of the references. Third, the cited references are not properly combinable for purposes of 35 U.S.C. §103(a).

A *prima facie* case of obviousness under 35 U.S.C. §103(a) requires that each and every claimed feature be found in the references. This is not the case. For example, Applicant recites in claim 1, a system for printing postal indicia at more than one location, using a host and more than one customer station. This is not disclosed by the proposed combination of references. Toshiba is a very compact multimedia home personal computer ("PC") that is connectable to a television ("TV") merely for the purpose of using the screen of the TV as the display means for the computer. The Toshiba PC is "connectable to a TV, other audiovisual (AV) equipment, or PC monitor." Toshiba makes absolutely no other disclosure relating to interacting with the TV or the TV system in a manner that could be considered "communicating" as is described and claimed by Applicant.

Thus, Toshiba is merely a compact computer that can use a television monitor as its display. Nothing more. The illustration of the Toshiba system shows it without a display. Toshiba does not disclose or suggest accessing any features of the television itself, communicating with the television system or order any type of services from the television as recited for example by Applicant in the claims. Toshiba does not disclose or suggest a "set-top box communicatively coupled with the television." In Applicant's invention the set-top box is used to obtain enhanced television services. No such disclosure is made in Toshiba. Although in Toshiba a user can remotely access the "computer", there is no disclosure that a user can remotely access the television or any of its functionalities. Toshiba is merely able to output its audio and video to "TVs and AV amplifiers." This is not what is recited and claimed by Applicant. Nothing in Toshiba even remotely suggests being able to order enhanced television services at the television. At most, the user can use the "computer" of Toshiba to surf the Internet with the video from the surfing being displayed on the screen of the TV. Nothing in Toshiba suggests that the user is surfing the Internet through the TV or TV services. Thus, at least the above features of Applicant's invention are not disclosed or suggested by Toshiba.

Also, as noted by the Examiner, Toshiba does not disclose or suggest a printer to print "postal indicium" on the label.

Kohorn does not overcome the deficiencies of Toshiba. First, Kohorn has nothing to do with postal indicia. In Kohorn, only tokens and coupons are generated in response to the user selecting product information. (Abstract, lines 1-2). The tokens or coupons then need to be taken by the user to be

"redeemed" at a "redemption facility" to effectuate any "value" of the token. (Col. 1, lines 60-63 and Col. 2, lines 25-26). This is quite different from Applicants' invention where the postal indicia, when printed, has an associated value that is already accounted for, and "redemption" at a "redemption facility" is not required. Furthermore, in Kohorn, the consideration of an authenticated token is, after redemption, then made available upon purchase of the product. In Applicants' invention, the customer station requests the postal indicia, which is eventually communicated cryptographically to the customer station. The postal indicia, when communicated has a "postage value" as recited in claim 1. Thus, this at least this aspect of Applicants' invention is neither disclosed nor suggested by Kohorn. It is also not suggested by the combination of Toshiba and Kohorn since Toshiba does not discuss or relate to the printing of postal indicia.

Furthermore, in Kohorn, the program signals having product information are transmitted to the remote locations. (Col. 2, lines 1-10). The product must be displayed to the user, who can, at the time the information is displayed, select a product of interest. (Col. 7, lines 59-61). Kohorn makes no mention of a user submitting a request for a specific product without some prompt, such as the information being displayed. In Applicant's invention, the user initiates the request without such prompting. The user pulls up a menu to select and generate the postage indicia. Thus, Kohorn does not disclose or suggest this feature of Applicants' invention. Toshiba also does not disclose or suggest at least this feature, so the combination cannot as well.

Kohorn also does not disclose or suggest accounting means as recited by Applicants in claim 1. In Kohorn, as discussed above,

the tokens or coupons have no value until they are presented for redemption at a redemption center. There is no adjustment of account information at the time the token or coupon is printed. In Applicant's invention, the information is modified at the time the postage indicia is generated or printed. Kohorn does not disclose or suggest storing information indicative of postage "value" printed at a customer station as is claimed by Applicants. There is also no such disclosure in Toshiba, and thus the combination of the two references cannot disclose or suggest this feature.

Col. 2, lines 1-6 of Kohorn, cited by the Examiner, does not teach means "responsive to information provided by the customer." Rather, Col. 2, lines 1-6 involves transmitting information regarding "at least one product available for purchase from a central location to remote locations." Nothing in Kohorn suggests information being provided by the customer. Rather, Kohorn, unlike Applicant's invention, deals with a customer's reaction to seeing a product or product information.

Essentially, what is happening in Kohorn is that product information is displayed on the TV while a user is viewing a program. The user can "select a product in which the viewer is interested" and then "activate the generating unit so as to print a token or discount coupon specifying such product or merchandise." (Col. 5, lines 57-61). Thus, in Kohorn, the products are displayed on the screen to the user. "In the course of a television program, viewers can be informed of special sales, discounts, or promotional offers or events." (Col. 6, lines 11-14). If the user sees something of interest, the user can activate the unit to generate a coupon. In Applicant's invention, the user does not receive such information. Rather,

the user makes the initial request to obtain postage indicia. Toshiba and Kohorn do not disclose or suggest means responsive to information provided by the customer at the remote control at one of said customer stations for sending to the host a first message requesting postal indicium. Thus, at least this feature is also not disclosed by the combination of Toshiba and Kohorn.

Kara does not overcome the deficiencies of Toshiba and Kohorn noted above and the combination of Kara with Toshiba and Kohorn also does not disclose or suggest each feature of Applicant's invention.

Kara relates to a portable processor that has a maximum amount of "preauthorized" postage that can be applied to a piece of mail. (Abstract, lines 1-5). The processor is used to store and dispense "credit value" to authorize shipping services. As shown in the figures, the processor is locally coupled to a computer, unlike Applicant's invention where a customer site is communicatively coupled to a remote host. Kara is merely a portable postage dispensing device that can be coupled to a host processor-based system at both the customer's site and the postal authority." (Col. 9, lines 1-5).

In Kara, the "portable postage dispensing device" is local to wherever the postage is being purchased. (Col. 9, lines 26-31). Only replenishment is discussed with regard to data exchange. (Col. 9, lines 50-59). Kara bears absolutely no relationship to ordering postal indicia through a television system and set-top box as recited by Applicant. Kara is merely a storage device that stores postage that can be dispensed. (Col. 10, lines 26-28; lines 61-64). In Kara, the storage device must be pre-loaded or filled. The user can then take the quantity of postage and use a program to dispense the postage as needed. (Col. 11, lines

32-35). Any menu items are purely local to the program being used. (Col. 11, lines 35-46). In Applicant's invention, Applicant recites ordering enhanced television services at the television and sending the host a first message requesting postal indicium. Rather, in Kara, the processor stores the postage and postage is debited from the processor device.

Kara is not used to "order" postal indicia from the postal authority as stated by the Examiner. Rather, Kara takes postage obtained from the postage authority that is stored on a storage device, and then uses a program, "E-STAMP" or "POSTAGEMAKER" to interact with the storage device and print postage. (Col. 11, line 32- Col. 14, line 35). As described and illustrated in Kara, the program is stored on a computer local to the storage device, unlike the communication connection between the host and the customer system of Applicant's invention. Thus, Kara, in combination with Toshiba and Kohorn, does not teach at least the above-mentioned features.

Also, Kara, together with Toshiba and Kohorn does not teach a host storing information indicative of postage value printed at each of the customer stations. Claim 9 of Kara referred to by the Examiner merely states an accounting system. However, in Applicant's invention the "host" stores information indicative of postage value printed at each customer stations. The stored information associated with customer station is modified within the accounting means.

The combination of Kara with Kohorn and Toshiba does not disclose or suggest this feature. In Kara, the postage comes directly out of the pre-loaded storage device. Kohorn does not involve billing or charging the customer because a "coupon" or "token" must be physically printed and then presented to be "redeemed."

Toshiba has no relation to a need to bill or charge for printed postal indicia since it only relates to using the television screen as the computer display.

Thus, claims 1, 2, 3, 4, 18 and 20 are not unpatentable over Toshiba, Kohorn, Kara and Ryan under 35 U.S.C. §103(a). Claims 5-17 and 19 should be allowable at least in view of their respective dependencies.

With regard to claim 5, the Examiner is incorrect that the customer uses Toshiba to surf the Internet. Nothing of the sort is disclosed. Rather, the proper application of Toshiba is the use of the computer in Toshiba to surf the Internet. The computer of Toshiba can use the television screen merely to display the images. Toshiba does not disclose or suggest a host remote from the customer station. Clearly in Toshiba, the PC must be near the TV in order for the PC to utilize the screen of the TV.

With regard to claim 10, neither Toshiba, Kohorn nor Kara teach postal security devices stored in a host. The references also do not refer to a network.

With regard to claim 11, there is no teaching of an operator of a host maintaining a set of accounts with respect to each customer in Kara, Toshiba or Kohorn. Kara is a storage device that is pre-loaded. As postage is dispensed, the amount stored in the device is depleted. There is nothing in Kara that teaches a set of accounts with respect to each customer. Each processing device will have its own depletion record. Neither Toshiba nor Kohorn deal with accounts of any type.

With regard to claim 13, Kara does not teach a host communicatively linked to a plurality of service providers as

described and claimed by Applicant. FIG. 8A of Kohorn shows the E-STAMP form or menu structure. Based on information stored in the processor device, different rates for different services can be calculated. This information must be pre-stored on the processor device, unlike Applicant's invention.

With regard to claim 14, Applicant respectfully traverses the Examiner's taking of Official Notice that Kara has PSD associated with a plurality of service providers. Why would that be? Information is pre-stored in the processing device. No such disclosure is made in Kara and the Examiner is requested to substantiate the statement.

With regard to claim 15, Toshiba makes absolutely no mention of a set-top box as described and claimed by Applicant. Toshiba uses the computer to surf the Internet, not the television set or any enhanced television services.

Claim 16 recites a "connection" between the host and a plurality of service providers. No such disclosure is made in Kara. Kara has information stored in the storage device. Although Kara may have certain information stored, Kara does not disclose or suggest the connection as claimed by Applicant.

With regard to claim 17, Toshiba makes absolutely no reference to a web television interface. The only reference to the television in Toshiba is the ability to utilize its display. Toshiba does not mention or utilize enhanced television services as claimed by Applicant.

Claim 18 recites accessing a host data center. Kara does not teach this. Kara can only provide comparisons based on information stored in the processing device. Kara does not

disclose or suggest the ability to solicit "quotes" as described and claimed by Applicant.

With regard to claim 19, Kara does not disclose or suggest being communicatively coupled to service providers. Kara merely accesses information stored about service provider rates in the device to provide comparison information. This is not the same as being communicatively coupled and obtaining live information.

Thus, the claims are not unpatentable over the combination of references cited by the Examiner.

2. Additionally, it is submitted that a *prima facie* case of obviousness under 35 U.S.C. §103(a) is not established because there is no motivation to combine Toshiba with Kohorn, Kara and Ryan to achieve Applicant's invention, as is required for obviousness under 35 U.S.C. §103(a). In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142 et. seq.). As noted above, Toshiba, Kohorn, Kara and Ryan do not disclose or suggest each feature of Applicants' invention as claimed.

Furthermore, none of these references provides the requisite suggestion or motivation to modify the references as proposed by the Examiner. The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not

supported by the factual contents of Toshiba, Kohorn, Kara and Ryan.

The references themselves and/or the knowledge generally available to one of skill in the art does not provide the requisite motivation or suggestion to modify the references as proposed for purposes of 35 U.S.C. §103(a). When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). There is no motivation to combine Toshiba and Kohorn with Kara. Toshiba merely relates to connecting a PC to a TV in order to use the TV screen as the computer display. Toshiba does not disclose or suggest using the TV as anything more than the audiovisual aspect of the home PC. Kohorn is directed to generating coupons and tokens that can be redeemed. Kohorn interacts with information provided through the television, for example, while watching a television show. (Col. 6, lines 11-14). Toshiba does not disclose or suggest watching "television shows" over the PC. However, in Kohorn, it is over these shows that the token and coupon information is generated. Thus, there is no motivation to combine Toshiba with Kohorn to achieve any aspect of Applicants' invention. Kara is directed to a portable postage dispensing device that can communicate with a personal computer. (Col. 9, lines 1-4). Kara does not relate to utilizing television services to obtain the indicia since the processor is local to the PC. Kohorn requires the enhanced television services in order to present information that might cause one to order the coupons.

Applicant recites ordering enhanced television services at the television and sending the host a first message requesting postal indicium. Kara does not involve "ordering" postage. Rather, in Kara, the processor stores a maximum amount of "preauthorized" postage that can be applied to a piece of mail. (Abstract, lines 1-5). The processor is used to store and dispense "credit value" to authorize shipping services. Kara is merely a portable postage dispensing device that can be coupled to a host processor-based system at both the customer's site and the postal authority." (Col. 9, lines 1-5).

The storage device 18 is shown in FIGS. 1A and 1B. Preferably the storage device 18 includes the "button 182". (Col. 10, lines 20-25). The storage device 18 can comprise a "SMART DISK" or "SMART CARD". (Col. 10, line 61 to Col. 11, line 7). This combination does not result in Applicant's invention.

Applicant's invention, as recited in claim 1, is directed to a system for printing postal indicia at more than one location and includes a "host" and more than one customer station. Kara, in combination with Toshiba and Kohorn does not achieve this. The storage device 18 in Kara, does not have application beyond the single system 10 it is physically coupled to. At most, the combination of Kara with Toshiba and Kohorn will allow a user to connect a storage device 18 to a computer (set-top box) to enable to "E-STAMP" and "POSTAGE MAKER" functionality. There is no teaching in this combination of references that provides for more than one customer station obtaining postal indicia from a single, remote, host. In Applicant's invention as recited in claim 1, the host and customer station are communicatively coupled and the host stores the postal security device.

Kara does not disclose or suggest the "accounting means" claimed by Applicant. Claim 9 of Kara merely states "accounting means". There is no discussion here of a host storing information indicative of postage value printed at each customer station. Toshiba, Kohorn and Kara all deal with a single customer station. Nor is there any discussion in the references of means responsive to the message identifying the customer station for modifying the stored information associated with the customer station within the accounting means.

In Applicant's invention any customer station can connect with the host via the set-top box. In Kara, the storage device 18 is unique to the PC shown. That information is "local", while in Applicant's it is remote. Nothing in any one of the references discloses such an arrangement. In Kara, the amount of postage printed is automatically deducted from the amount stored within the portable processor button 182 by the button itself. The usage record for the portable processor is kept internally.

Ryan does not add anything that would lead one to make the combination. Ryan does not relate to obtaining postage indicia over a television.

Thus, given the differences and distinctions between Applicant's invention and each reference, and the references themselves, it is clear that a person of skill in the art would not be motivated to combine the reference teachings in an attempt to achieve Applicant's invention. The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the references. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Toshiba, Kohorn, Kara and Ryan under 35 U.S.C. §103(a) is not established.

3. The Applicants respectfully note that Toshiba, Kohorn, Kara and Ryan have been combined improperly. References may be combined under 35 U.S.C. §103(a) only if the references are analogous art. In this case Toshiba, Kohorn, Kara and Ryan are not analogous art. A reference is analogous art if:

1) The reference is in the same field of endeavor as the applicant's, or

2) The reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Toshiba is directed to using a television screen as a display for a computer. This is totally unrelated to a system for printing postal indicia. Toshiba merely wants to enhance the audiovisual aspects of a computer that has a DVD, for example. This is totally unrelated to obtaining postal indicia using a television and a set-top box system that can order enhanced television services at the television. Thus, Toshiba is not in the same field of endeavor as Applicant's invention and is not reasonably pertinent to the problem of obtaining postal indicia.

In Kohorn, only tokens and coupons are generated. (Abstract, lines 1-2). The tokens or coupons then need to be "redeemed" at a "redemption facility" to effectuate any "value" of the token. (Col. 1, lines 60-63 and Col. 2, lines 25-26). This is quite different from Applicants' invention where the postal indicia, when printed, has an associated value, and "redemption" at a "redemption facility" is not required. Furthermore, in Kohorn, the consideration of an authenticated token is, after redemption, then made available upon purchase of the product. In Applicant's invention, the customer station requests the postal indicia,

which is eventually communicated to the customer station. The postal indicia, when communicated has a "postage value".

Furthermore, in Kohorn, the program signals having product information are transmitted to the remote locations. (Col. 2, lines 1-10). The product must be displayed to the user, who can, at the time the information is displayed, select a product of interest. (Col. 7, lines 59-61). Kohorn makes no mention of a user submitting a request for a specific product without some prompt, such as the information being displayed. In Applicants' invention, the user initiates the request without such prompting. Thus, although Kohorn may use a set-top box to generate coupons or tokens, these coupons and tokens are nothing like postal indicia, and Kohorn does not even suggest that a secure transaction, which is needed for postal indicia generation, could take place.

Thus, Kohorn is not in the same field of endeavor as Applicant's invention and is not reasonably pertinent to the problem of obtaining postal indicia.

Kara merely relates to a storage device that stores postal indicia. It has no relationship to ordering postage indicia over a television system. Storing postage to be dispensed in a portable processing device is not related to ordering postal indicia over a television system from a host as described and claimed by Applicant. Thus, Kara is not in the same field of endeavor as Applicant's invention and is not reasonably pertinent to the problem of obtaining postal indicia over a television system from a host.

Ryan relates to obtain postage from a traditional postage machine system and not via a television system from a host as described

and claimed by Applicant. Thus, Ryan is also not properly combinable for purposes of 35 U.S.C. §103(a).

4. Claims 3 and 4 are not unpatentable over "Toshiba" in view of "Kohorn" further in view of "Canon", "Kara" and "Ryan" under 35 U.S.C. §103(a).

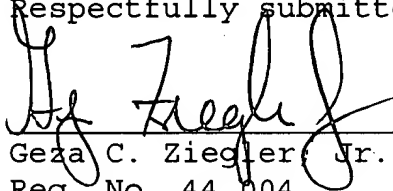
The arguments raised with respect to Toshiba, Kohorn, Kara and Ryan are reasserted here.

Canon is a fax machine. Canon does not overcome any of the deficiencies noted with respect to the other references. Thus, claims 3 and 4 should be allowable.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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